

APR 21 2006



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FAX COVER SHEET

DATE: April 21, 2006

TO: USPTO

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Number of pages including cover sheet: 5

RE: Application No. 10/622,868
Attorney Docket No.: PB10046.00

o Response to Restriction Requirement

Alleviating pain, Restoring health, Extending life

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/622,868 Confirmation No. 2912
Applicant : Patrick F. Kelly *et al.*
Filed : July 17, 2003
Examiner : Eric D. Bertram
TC/AU : 3766
Docket No. : PB10046.00 Customer No. 53049
Title : External Defibrillator and Methods for Operating the External
Defibrillator

CERTIFICATE OF FACSIMILE TRANSMISSION: I hereby certify that this paper and all paper(s) described herein are being facsimile transmitted to the United States Patents and Trademarks Office on

April 21, 2006

Signature

Printed Name *Mary Kay Redman*

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This responds to the Office Action mailed on 03/21/2006, in which the Examiner requires restriction be made to one of the following inventions (characterizations of claim groups below are the Examiner's):

- I. Claims 1-8, 17-25 and 35-42, drawn to a method of operating an external defibrillator, classified in class 607, subclass 005;
- II. Claims 51-57, drawn to a method for charging an energy storage device of an external defibrillator, classified in class 607, subclass 011;

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- III. Claims 65-68 and 76-78, drawn to methods for delivering subsequent defibrillator shocks, classified in class 607, subclass 005;
- IV. Claims 72 and 73, drawn to a method for delivering a defibrillation shock without physiological analysis, classified in class 607, subclass 005;
- V. Claim 82, drawn to a method of providing a defibrillation shock through a plurality of electrodes, classified in class 607, subclass 005; and
- VI. Claims 9-16, 26-34, 43-50, 58-64, 69-71, 74, 75, 79-81 and 83, drawn to an external defibrillator, classified in class 607, subclass 010.

In response to this restriction requirement, Applicant elects group 1, Claims 1-8, 17-25 and 35-42 with traverse.

The MPEP states, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (MPEP, §803). In this case, the Examiner admits that the inventions claimed in groups I, III, IV and V are all classified in class 607, subclass 005. These claim groups involve closely related subject matter. Applicant respectfully submits that given the common classification of these groups and the closely related subject matter of all the groups, they can most effectively and efficiently examined together with no serious burden on the Examiner.

In Para. 3 of the Detailed Action, the Examiner comments on the inventions claimed in groups V and VI:

"In this case the apparatus as claimed [*invention VI*] can be used to perform a physiology analysis, which is not required by the process [*invention V*]."

Apparatus claims 58, 59, 60, 62, 63, 79, 81 and 83 (in group VI) do not include language requiring performance of a physiology analysis. Independent claim 74 (also in group VI) includes language directed to an external defibrillator including a controller configured to

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“deliver the defibrillation shock in response to receiving said firing input, which occurs *without the external defibrillator conducting a physiology analysis of the patient.*” (last three lines of claim 7. Emphasis added). Thus, it is not necessarily the case that the apparatus as claimed can be used to perform a physiology analysis.

In Para. 4 of the Detailed Action, the Examiner states that the processes of the inventions described in the claims of groups I and II are mutually exclusive because “invention I describes discharging the energy storage device from a first charge level, while invention II requires that the shock be delivered from a second discharge level that is lower than the first charge level.” However, the claims of group I do not include language directed to the energy level from which discharging or shock delivery takes place. Thus, it is not the case that the invention I describes discharging the energy storage device from a first charge level.

In Para. 6 of the Detailed Action, the Examiner states that “inventions I, II, and II [*Applicant takes this to mean III*] require a physiology analysis to occur prior to defibrillation...” Claims 17-25, 35, 38 and 39 (group I) do not recite a time order requiring physiology analysis to occur prior to defibrillation. Claims 51-53, 55 and 56 (group II) do not recite a physiology analysis. Claims 54 and 57 (group II) do not recite a time order requiring physiology analysis to occur prior to defibrillation. Claims 65-66 (group III) do not recite delivery of a shock subsequent to a physiology analysis. Claims 76 and 78 (group III) do not recite a physiology analysis. Claim 77 (group III) does not recite a time order requiring physiology analysis to occur prior to defibrillation. Thus, it is not necessarily the case that inventions I, II, and III require a physiology analysis to occur prior to defibrillation.

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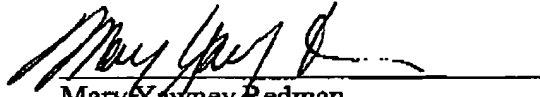
Applicant believes that no fee is required for entry of this response. However, if a fee is required to process this response, please charge that fee to Deposit Account No. 13-2546.

If a telephone conference would be of assistance in consideration of this response, the Examiner is invited to telephone Mary Redman at (425) 867-4465.

Respectfully submitted,

Date:

April 21, 2006



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